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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,057	12/13/2000	Marjorie C. Ravitz	15173.200	6585

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EXAMINER

PICKETT, JOHN GREGORY

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

09/736,057

Applicant(s)

RAVITZ ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7, 10, 12-13, 15-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Potter (US 5,714,098).

Regarding claim 1, Potter discloses a foot wear fitting method (Figure 11) comprising the steps of maintaining an inventory of shoes 63, measuring the size and width 55 and arch height (Col. 5, ln 34-37), selecting the proper size 63, and fitting the shoe to the customer 75.

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On page 15, lines 5-9 of the specification of the present application, applicant defines the flat inner foot receiving surface as having all arch support or otherwise normally provided cushioning removed. Potter anticipates inserting an orthotic onto the flat inner foot receiving surface of the shoe (Col. 9, ln 26-41). The examiner interprets the broad term, insert, used by Potter, to include orthotics.

As to claims 2-3, Potter anticipates an inventory of prefabricated orthotics (Col. 9, ln 34-36).

As to claims 4-5, Potter anticipates a custom made orthotic fabricated from the size, width, and arch height for each foot (Col. 9, ln 42-50).

As to claim 7, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, ln 41-46).

As to claim 10, Potter measures at least one width for each foot (step 55).

As to claims 12-13, Potter anticipates a system having an inventory of shoes (step 63), sample insoles are a device for measuring the size, width and arch height (Col. 9, ln 42-44), an inventory of prefabricated orthotics having a range of sizes and arch heights (Col. 9, ln 26-41), and fitting the combination on the customer (step 75).

As to claims 15-16, Potter anticipates a system having an inventory of shoes (step 63), sample insoles are a device for measuring the size, width and arch height (Col. 9, ln 42-44), custom made orthotics fabricated from the measurements of the size, width, and arch heights (Col. 9, ln 42-50), and fitting the combination on the customer (step 75).

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As to claim 18, Potter anticipates a variety of shoe types, including dress shoes (Col. 5, ln 41-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 6, 8-9, 11, 14, 17, 19-20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter.

Regarding claims 6 and 17, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not disclose an orthotic which is a prescription orthotic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use prescription orthotics in the method and system of Potter in

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order to offset the price of the shoe to the customer through insurance coverage available through a prescription orthotic.

As to claims 8-9 and 19-20, Potter discloses a method and system as applied to claims 1 and 15 above. Potter does not expressly disclose women's fashion shoes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make women's fashion shoes available to the method and system of Potter in order to supply a greater choice to female customer's.

As to claims 14 and 21, Potter discloses a system as applied to claims 12 and 15 above. Potter does not disclose a device for measuring width that includes indicia for measuring at least one width. The standard Brannock device available to most retail shoe stores includes indicia for measuring at least one foot width.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Brannock device in the system of Potter in order to pre-size the customer's foot and reduce the number of sample insoles required to be tried by the customer, thereby expediting the sizing process.

As to claim 11, Potter discloses a method as applied to claim 1 above. Potter does not disclose the selection of the shoe style over the Internet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide shoe selection options over the Internet to the method of Potter in order to reduce inventory requirements at the retail store.

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4. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyland (US 2,162,916) in view of Genest (US 5,822,223).

Regarding claim 22, Hyland discloses a device (Figure 1), with a surface 20, first reference 21, third reference 26, first indicia 30, third indicia 27, and mechanism 31 for measuring the height of the arch. Hyland is arranged to measure the left foot and can be arranged to measure the right foot through the manipulation of parts (Col. 4, ln 5-18).

Hyland does not expressly disclose a second reference for the right foot or a second indicia for the right foot.

Genest discloses a foot measuring apparatus that is symmetrical with indicia and abutments for measuring both the left and right foot.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Hyland to include a second reference and second indicia for measuring the right foot, making the device symmetrical as taught by Genest in order to eliminate the need to manipulate parts to read both feet of the customer, thereby reducing the customer's wait.

As to claim 23, third indicia 27 includes three parallel lines. It would have been obvious to include three parallel lines in the second indicia of Hyland as modified by Genest in order to maintain symmetry.

As to claim 24, Hyland discloses wedge 33 movable towards and away from the arch of the foot and indicia 37. Hyland does not disclose a second wedge opposite wedge 33.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a second wedge opposite wedge 33 and a second indicia in the device of Hyland as modified by Genest in order to maintain symmetry.

5. Claims 25-26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. (US 5,640,779).

Regarding claim 25, Rolloff et al. discloses a device 10 for measuring foot size with housing 14, first reference 52, second reference 54, third reference 56, and scanners 108.

Rolloff et al. does not expressly disclose first, second, and third indicia. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff et al. with indicia as claimed by the applicant in order to visually verify the measurements taken by the device and further to quickly determine shoe sizing for reception of the completed orthotic.

As to claim 26, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the second and third indicia of the modified Rolloff et al. device with at least three parallel lines since parallel lines for indicating width are common and conventional in the shoe sizing art.

As to claim 28, Rolloff et al. discloses processor 162.

As to claim 29, Rolloff et al. discloses modeler 216.

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6. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rolloff et al. as applied to claim 25 above, and further in view of White (US 5,237,520).

Rolloff et al. discloses a device as mentioned and modified above. Rolloff et al. does not disclose scanners comprising CCD imagers.

White discloses a foot sizing device with laser-optic scanners (Col. 5, ln 45-52). Laser-optic scanners use a CCD array.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Rolloff et al. with CCD imagers as taught by White in order to reduce the number of moving parts necessary for the device to function.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Internet sales brochure discloses the common Brannock device. Dananberg et al. (US 5,373,650) discloses an orthotic device for high-heeled shoes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

GP
Gregory Pickett
Examiner
December 2, 2002



LUAN K. BUI
PRIMARY EXAMINER